# REMARKS

These remarks are responsive to the December 18, 2009 Decision by the Board of Patent Appeals and Interferences (hereinafter, the "Board"). Currently, claims 1-34, 36-38, 40-43, and 45 are pending in the present application with claims 1, 8, and 24 being independent. Claims 35, 39, and 44 have been cancelled without prejudice or disclaimer. Claims 1, 8, 24, 40-43, and 45 have been amended to expedite prosecution of this application to allowance. Claims 40-43 and 45 have been amended to correct dependency of these claims. Support for amendments to claims 1, 8, and 24 can be found in Applicants' specification at least on page 4, line 15 to page 7, line 2. No new matter has been added.

The following discussion addresses references cited by the Examiner in the Final Office Action and relied upon by the Board in its December 18, 2009 Decision.

## *35 U.S.C. 102*

Claims 1-10, 12-19, 21-31, 33-41 and 44-45 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,732,216 to Logan (hereinafter, "Logan"). Applicants respectfully disagree and traverse this rejection. Claims 35, 39, and 44 have been cancelled without prejudice or disclaimer and as such the rejection of these claims is now moot.

Amended claim 1 recites, *inter alia*, an electronic message configured to be communicated between a sender's device and a recipient's device. The electronic message includes a sound file attached to the electronic message and a predetermined identifier also attached to the electronic message and associated with the sound file. The predetermined identifier distinguishes the sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with the sound file. Based on the course of action indicated by the predetermined identifier, the recipient's device is configured to selectively convert a content of the electronic message from text to voice using one of the sound file and/or locally stored voice sample. The recipient's device is configured to selectively play the sound file and/or the converted content of the electronic message.

As understood by Applicants, Logan relates to an audio message exchange system in which multiple exchanges of information are made between a host server and a player device (Logan, Abstract, FIG. 1). The user of the player device can listen to audio content from the host

server at times chosen by the user and can submit to the host server audio annotations/comments regarding its content. *Id.* The audio content can include programs and advertisements matching preferences associated with a user of the player device. *Id.* These multiple exchanges within the Logan system include:

- the player device uploading user information/preferences to the host server (Logan, stage 203, FIG. 2, "Establish Account"),

- the host server compiling audio content matching the user preferences, the player device periodically contacting the host server to download the compiled audio content based on time of day clock (Logan, FIG. 1; Col. 5, lines 45-62; "Download Compilation"),

- the player device downloading the requested content and a recommended sequence file identifying a default order in which the audio content can be played back (which can be modified by the user before playback begins) (Logan, Col. 7, lines 36-45),

- a user of the player device accessing the player device and entering a valid password (Logan, FIG. 3, "Accept Password"),

- the player device allowing the user to listen to the audio content in the default sequence or in a new order specified by the user, or to end the session altogether without the audio ever being played (Logan, Col. 11, line 16 to Col. 12, line 16), and

- a user of the player device submitting annotations and comments to audio content, which can be uploaded to the host server and/or stored locally by the player device (Logan, FIG. 3; Col. 19, lines 27-33, "Record User's Response").

Logan further discloses that a comment/annotation generated by a user of the player device can be e-mailed as an audio attachment (e.g., a RealAudio file) to the e-mail address(es) of other subscribers. (Logan, Col. 42, line 67 to col. 43, line 2). Using a program_id, Logan identifies different segments of a program that are to be played. (Logan, Col. 7, lines 30-46). Further, Logan discloses a program_id that identifies segments of the program but Logan does not disclose that the program_id is transmitted with the e-mail, or even mention the possibility of attaching other files to the e-mail. Whereas, the present invention's predetermined identifier is attached to the email, as recited in claim 1. Logan's player device identifies files it wishes to download by their filenames using such program_id. (Logan, Col. 7, lines 30-35). In contrast, Logan's program_id does not identify any course of action to be taken by the recipient device.

In Logan, a user makes a request to download and play the files (i.e., program segments). The program_id links the segments (Logan, Col. 16, lines 52-53) but does not provide any a course of action to be taken by the recipient's device with the sound file, as recited in claim 1. Logan's program_id merely identifies the filenames of the audio files. Despite the presence of Logan's program_id, the recipient device may take no action with the audio files.

Logan's device fails to disclose that based on the course of action indicated by the predetermined identifier, the recipient device selectively converts content of the electronic message from text to voice using the sound file and/or the locally stored sample, as recited in claim 1. Instead, Logan, for a given program segment, can speech-synthesize a text transcript for listening in a sequence by the user (Logan, Co. 28, line 19-26). Logan fails to use the sound file and/or the locally stored voice sample to selectively convert content of the electronic message (or any text) to voice. Further, Logan appears to provide the user with only two options: recorded audio narration and text transcript or converted text transcript alone. *Id.* Hence, Logan fails to selectively convert content of the electronic message from text to voice using the sound file enclosed with the electronic message and/or locally stored voice sample, as recited in claim 1. Further, the Examiner failed to indicate what is being used by Logan to convert text to voice. In fact, Logan uses "speech synthesis" for such conversion, which is different than the present invention that implements use of the sound file and/or the locally stored voice sample for conversion purposes. Hence, Logan also fails to disclose that its devices are configured to selectively play the sound file and/or the converted content of the electronic message, as a result of the course of action indicated by the predetermined identifier.

Thus, the predetermined identifier of the presently claimed embodiments is different from Logan's program_id, because it (1) is attached to the electronic message; (2) is associated with the sound file attached to the electronic message; (3) distinguishes the sound file from all other files attached to the electronic message; (4) indicates a course of action to be taken by the recipient's device; and (5) based on the course of action indicated by the predetermined identifier, the recipient's device is configured to selectively convert content of the electronic message from text to voice using the sound file and/or locally stored sample. This is contrary to the recitation of claim 1. Logan's program_id simply indicates filenames of program segments that may be identified in a sequence file that further indentifies a particular order in which such program segments are to be played. (Logan, Col. 7, lines 36-41; FIG. 5). Hence, Logan's

program_id does not carry the information and is not capable of carrying the information that is provided by the predetermined identifier of the present invention, because it is a mere indicator of a program segment in Logan. If Logan's user wishes to play a particular segment of a program, a specified program_id associated with that segment will be used to call out the segment and play it for the user, however, no course of action is indicated by Logan's program_id, contrary to the recitation of claim 1.

Hence, Logan fails to disclose all elements of claim 1 and as such, does not anticipate it. Applicants respectfully request allowance of claim 1.

Independent claims 8 and 24 are not anticipated by Logan for at least the reasons stated above with regard to claim 1. As such, the rejection of claims 8 and 24 is respectfully traversed. The Examiner is requested to reconsider and withdraw this rejection of claims 8 and 24.

Dependent claims 2-7, 9-10, 12-19, 21-23, 25-31, 33-34, 36-38, 40-41 and 45 are not anticipated for at least the reasons stated above with regard to claims 1, 8, and 24, respectively. As such, the rejection of claims 2-7, 9-10, 12-19, 21-23, 25-31, and 45 is respectfully traversed. The Examiner is requested to reconsider and withdraw this rejection of claims 2-7, 9-10, 12-19, 21-23, 25-31, and 45.


_35 U.S.C. 103_

Claims 11, 20, 32, 42, and 43 have been rejected under 35 U.S.C. 103(a) as being unpatentable over of Logan in view of U.S. Patent No. 6,085,231 to Agraharam et al. (hereinafter, "Agraharam"). This rejection is respectfully traversed.

Claims 11, 20, 32, 42, and 43 are dependent based on the independent claims 1, 8, and 24, respectively. As such, these claims are patentable over Logan for at least the reasons stated above with regard to claim 1. Agraharam fails to cure the deficiencies of Logan.

As understood by Applicants, Agraharam appears to relate to a subscriber-to-alias telephone number email system that can retrieve both voice-mail message and email message by accessing only an email system. (Agraharam, Abstract). Agraharam converts voice mail messages and attaches them to emails for transmission over the Internet. A subscriber of the Agraharam system is able to retrieve emails containing converted voice mails and listen to them. (Agraharam, Col. 1, line 51 to Col. 2, line 9).

Agraharam is different from the present invention and fails to disclose, teach or suggest a predetermined identifier that is attached to the electronic message and is associated with a sound file being attached to the electronic message, where the identifier indicates a course of action to be taken by the recipient's device with the sound file, where based on the course of action indicated by the identifier, the recipient's device selectively converts a content of the electronic message from text to voice using the sound file and/or a locally stored sample, as recited in claim 1. Instead, Agraharam appears to deal with simple format conversion of sound files so that they can be attached to emails. Agraharam converts voicemails to .WAV or text files and then forwards them to users in an email. This is contrary to the intents and purposes of the present invention, as indicated by the currently pending claims.

One having ordinary skill in the art and armed with the knowledge of Logan would not look to Agraharam to solve Logan's deficiencies. Logan deals with listening to various program segments identified by a program_id in a particular sequence file. In contrast, Agraharam deals with conversion of files from one format to another (.WAV or text) for attachment or insertion into an email. However, both references as well as their implausible combination fail to disclose, teach or suggest a predetermined identifier attached to the electronic message and associated with the sound file, that both distinguishes the sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with the sound file and that based on the course of action indicated by the predetermined identifier, the recipient's device is configured to selectively convert a content of the electronic message from text to voice using one of the sound file and/or locally stored voice sample, as recited in the currently pending claims. Hence, one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner or the Board's Decision suggests and would not come up with the invention which Applicants conceived.
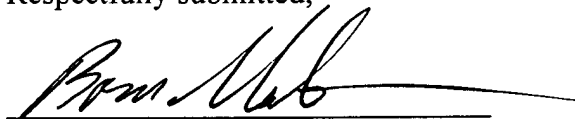
Thus, the combination of Logan and Agraharam does not support a *prima facie* case of obviousness and the rejection of claims 11, 20, 32, 42 and 43 is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw this rejection of the claims.

## CONCLUSION

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney and agent to expedite further processing of the application to allowance.

Dated: February 12, 2010

Respectfully submitted,

Boris A. Matvenko, Reg. No. 48,165  
Attorney/Agent for Applicants  
MINTZ LEVIN COHN FERRIS  
GLOVSKY AND POPEO, P.C.  
Chrysler Center  
666 Third Avenue  
New York, New York 10017  
(212) 935-3000  
(212) 983-3115

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